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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,322	04/26/2001	Casey William Norman	1391-CON-00	1969

35811 7590 03/28/2006

IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP  
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PHILADELPHIA, PA 19103

EXAMINER
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FRANCIS, FAYE

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/844,322

Applicant(s)

NORMAN ET AL.

Examiner

Faye Francis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-23, 25, 26 and 28-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-23, 25, 26 and 28-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the appeal brief filed on 1/9/06, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 20—23, 25-26 and 28-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21-22, 38 and 47 are indefinite since all that the applicant considers to be encompassed by the phrase “in a life-like way” cannot be determined.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-23, 25, 28 and 30-34 are rejected under 35 U.S.C. 103(a) as being obvious over O'Brian et al [2,944,368], hereinafter O'Brian in view of Kramer [5,607,339] and either Gross [5,913,708] or Wion [4,294,036].

O'Brian discloses in Figs 1-7, a garment [blouse 30] comprising a flexible and elastic molded thermoplastic elastomer [col 3 lines 54-56 and col 4 line 58 and also **[[re-sil-ient (rî-zîl'yent) adjective 1. Capable of returning to an original shape or position, as after having been compressed.]** according to Merrian-Webster's Collegiate Dictionary Tenth Edition] doll's garment having a molded shape to fit over external surfaces of at least a portion of a doll [Fig 4], has a through hole [insofar as the applicant has claimed blouse 30 is considered to have a through hole [the opening for the neck for example]]. Additionally, please note that O'Brian start with a flat sheet of material, which is then formed into three-dimension article.

O'Brian does not disclose that doll having articulated limbs as recited in claim 21 and 22, a doll's garment formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 1 MN/M2).

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Kramer teaches the concept of providing a doll, a doll's garment (col 1 lines 51-57) formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 750 pound per square inch (less than 1 MN/M<sup>2</sup>). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the doll's garment of O'Brian to have thickness and with modulus of elasticity as taught by Kramer to provide more flexibility.

Either Gross or Wion teaches that it is conventional to have articulated shoulders, elbows, knees, neck, and hips in a play set comprising a doll and a doll's garment or in a planar doll [two dimensional]. It would have been obvious to further provide the modified device of O'Brian with the articulated doll as disclosed by either Gross or Wion, for the purpose of making the device more realistic and enjoyable for the children to play with.

With respect to the injection molded thermoplastic elastomer in claims 21-22, is considered to be process steps in product claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) [see MPEP 2113 regarding how product by process claims are treated in claims].

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6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brian et al in view of Kramer and either Gross or Wion as applied to claims 21-23, 25, 28 and 30-34 above and further in view of Whitney et al [6,475,609], hereinafter Whitney.

Modified device of O'Brian has most of the elements of this claim but for a finish selected from the group consisting of paint, varnish, and glitter.

Whitney teaches that it is conventional to adhere glitter to the surface of or embedded in articles such as clothing to enhance their visual appearance [col 1 lines 42-45]. It would have been obvious, in view of Whitney to even further provide modified the doll's garment of O'Brian with glitter in order to enhance their visual appearance.

7. Claims 20, 29 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brian et al in view of Kramer and either Gross or Wion as applied to claims 21-23, 25, 28 and 30-34 above and further in view of Yasuda [5,928,803].

Modified device of O'Brian has most of the elements of these claims but for the specific thermoplastic elastomer material.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54) in order to make clothes for dolls as the constituent element of dolls). It would have been obvious to further make the modified device of O'Brian out of thermoplastic elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

8. Claims 38-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brian in view of Kramer, Yasuda and either Gross or Wion.

O'Brian modified in view of Kramer discloses most of the elements of these claim [see paragraph 5 above] but for the specific thermoplastic elastomer material and that doll having articulated limbs.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54) in order to make clothes for dolls as the constituent element of dolls). It would have been obvious to further make the modified device of O'Brian out of thermoplastic elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

Either Gross or Wion teaches that it is conventional to have articulated shoulders, elbows, knees, neck, and hips in a play set comprising a doll and a doll's garment or in a planar doll [two dimensional]. It would have been obvious to further provide the modified device of O'Brian with the articulated doll as disclosed by either Gross or Wion, for the purpose of making the device more realistic and enjoyable for the children to play with.

With respect to claim 46: it is generally well known to decorate garment with paint. Therefore, it would have been obvious to further modify the O'Brian 's device to have paint for aesthetic reasons.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 20-51 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 571-272-4423. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF

Faye Francis

A handwritten signature in black ink, appearing to read 'D. Banks', with a long horizontal line extending to the right.

**DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700**